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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/504,965

Applicant(s)

HOU ET AL.

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment was received on 7/14/05, and has been entered and made of record. Currently, **claims 1-22** are pending.

### *Response to Arguments*

2. Applicant's arguments, see pages 8-10, filed 7/14/05, with respect to the rejection(s) of claim(s) 1, 8, 13, and 18 under 35U.S.C.102 as being anticipated by Wolff *et al.* (U.S. Patent Number 5,848,413) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Geshwind (WIPO Publication Number WO 91/01606).

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1, 3-8, 10-13, 15-18, and 20-22** are rejected under 35 U.S.C. 102(b) as being anticipated by Geshwind (WIPO Publication Number WO 91/01606).

Regarding *claim 1*, Geshwind discloses a network fax machine for faxing files received from a remote client (see Fig. 2), comprising a server unit configured to send a fax document

form (see Fig. 1) to a remote client over a network (page 9, paragraph 3-page10, paragraph 1, and page 12, paragraph 2) and configured to receive fax information entered on the fax document form from the remote client (page 9, paragraph 3-page10, paragraph 1), the fax information including (1) an identifier identifying a destination fax machine (see Fig. 1, and page 9, paragraph 3-page10, paragraph 1) and (2) a file to be faxed to the destination fax machine (page 9, paragraph 3), and a fax control unit configured to use the identifier to connect the network fax machine to the destination fax machine and configured to send the file to the destination fax machine by facsimile communication (page 9, paragraph 3-page10, paragraph 1), wherein the destination fax machine is located remotely from the remote client (page 10, paragraph 1).

Regarding *claim 3*, Geshwind discloses the fax machine discussed above in claim 1, and further teaches of a network adapter, the network adapter including the server unit (page 1, paragraph 2-page 2, paragraph 5, and page 9, paragraph 3).

Regarding *claim 4*, Geshwind discloses the fax machine discussed above in claim 3, and further teaches that the network adapter comprises a network interface card (page 1, paragraph 2-page 2, paragraph 5, and page 9, paragraph 3).

Regarding *claim 5*, Geshwind discloses the fax machine discussed above in claim 1, and further teaches that the fax control unit is configured to connect to a public switched telephone network (page 19, paragraphs 1-5) and is configured to send the file to the destination fax machine via the public switched telephone network (page 9, paragraph 3-page10, paragraph 1, and page 19, paragraphs 1-5).

Regarding **claim 6**, Geshwind discloses the fax machine discussed above in claim 1, and further teaches of a common gateway interface configured to read and parse the fax information received by the server unit (page 9, paragraph 3-page10, paragraph 1).

Regarding **claim 7**, Geshwind discloses the fax machine discussed above in claim 6, and further teaches of a fax job manager configured to convert the file to be faxed into a facsimile format (page 21, paragraphs 2-paragraph 4).

Regarding **claim 8**, Geshwind discloses a method for faxing files received from a remote client (see Figs. 1 and 2), comprising sending a fax document form to a remote client over a network (page 9, paragraph 3, and page 12, paragraph 2), receiving fax information entered on the fax document form from the remote client (see Fig. 1, page 9, paragraph 3-page 10, paragraph 1), the fax information including (1) an identifier identifying a destination fax machine (page 9, paragraph 3-page10, paragraph 1) and (2) a file to be faxed to the destination fax machine (page 9, paragraph 3), connecting the network fax machine to the destination fax machine using the identifier (page 9, paragraph 3-page10, paragraph 1), and sending the file to the destination fax machine by facsimile communication (page 9, paragraph 3-page10, paragraph 1), wherein the destination fax machine is located remotely from the remote client (page 10, paragraph 1).

Regarding **claim 10**, Geshwind discloses the method discussed above in claim 8, and further teaches that the connecting step comprises connecting to a public switched telephone network (page 19, paragraphs 1-5) and wherein the sending step comprises sending the file to the destination fax machine via the public switched telephone network (page 9, paragraph 3-page10, paragraph 1, and page 19, paragraphs 1-5).

Regarding *claim 11*, Geshwind discloses the method discussed above in claim 8, and further teaches of reading and parsing the fax information received from the remote client (page 9, paragraph 3-page10, paragraph 1).

Regarding *claim 12*, Geshwind discloses the method discussed above in claim 11, and further teaches of converting the file to be faxed into a facsimile format (page 21, paragraphs 2-paragraph 4).

Regarding *claim 13*, Geshwind discloses a network fax machine for faxing files received from a remote client (see Figs. 1 and 2), comprising means for sending a fax document form to a remote client over a network (page 9, paragraph 3, and page 12, paragraph 2), means for receiving fax information entered on the fax document form from the remote client (see Fig. 1, page 9, paragraph 3-page 10, paragraph 1), the fax information including (1) an identifier identifying a destination fax machine (page 9, paragraph 3-page10, paragraph 1) and (2) a file to be faxed to the destination fax machine (page 9, paragraph 3), and means for connecting the network fax machine to the destination fax machine using the identifier (page 9, paragraph 3-page10, paragraph 1), and means for sending the file to the destination fax machine by facsimile communication (page 9, paragraph 3-page10, paragraph 1), wherein the destination fax machine is located remotely from the remote client (page 10, paragraph 1).

Regarding *claim 15*, Geshwind discloses the fax machine discussed above in claim 13, and further teaches that the means for connecting comprises means for connecting to a public switched telephone network (page 19, paragraphs 1-5) and wherein the means for sending comprises means for sending the file to the destination fax machine via the public switched telephone network (page 9, paragraph 3-page10, paragraph 1, and page 19, paragraphs 1-5).

Regarding *claim 16*, Geshwind discloses the fax machine discussed above in claim 13, and further teaches of means for reading and parsing the fax information received by the means for receiving (page 9, paragraph 3-page10, paragraph 1).

Regarding *claim 17*, Geshwind discloses the fax machine discussed above in claim 16, and further teaches of means for converting the file to be faxed into a facsimile format (page 21, paragraphs 2-paragraph 4).

Regarding *claim 18*, Geshwind discloses a computer readable medium containing program instructions for execution on a computer system (page 23, paragraph 3), which when executed by a computer, cause the computer to perform method steps for faxing files received from a remote client (see Fig. 2), comprising sending a fax document form to a remote client over a network (page 9, paragraph 3, and page 12, paragraph 2), receiving fax information entered on the fax document form from the remote client (see Fig. 1, page 9, paragraph 3-page 10, paragraph 1), the fax information including (1) an identifier identifying a destination fax machine (page 9, paragraph 3-page10, paragraph 1) and (2) a file to be faxed to the destination fax machine (page 9, paragraph 3), connecting the network fax machine to the destination fax machine using the identifier (page 9, paragraph 3-page10, paragraph 1), and sending the file to the destination fax machine by facsimile communication (page 9, paragraph 3-page10, paragraph 1), wherein the destination fax machine is located remotely from the remote client (page 10, paragraph 1).

Regarding *claim 20*, Geshwind discloses the medium discussed above in claim 18, and further teaches that the step of connecting comprises connecting to a public switched telephone network (page 19, paragraphs 1-5) and wherein the step of sending comprises sending the file to

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the destination fax machine via the public switched telephone network (page 9, paragraph 3-page10, paragraph 1, and page 19, paragraphs 1-5).

Regarding *claim 21*, Geshwind discloses the medium discussed above in claim 18, and further teaches of instructions to perform the step of reading and parsing the fax information received from the remote client (page 9, paragraph 3-page10, paragraph 1).

Regarding *claim 22*, Geshwind discloses the medium discussed above in claim 21, and further teaches of instructions to perform the step of converting the file to be faxed into a facsimile format (page 21, paragraphs 2-paragraph 4).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 2, 9, 14, and 19** rejected under 35 U.S.C. 103(a) as being unpatentable over Geshwind (WIPO Publication Number WO 91/01606) in view of Wolff (U.S. Patent Number 5,848,413, cited in the Office action dated 4/29/05).

Regarding *claims 2, 9, 14, and 19*, Geshwind discloses the fax machines, method, and medium discussed above in claims 1, 13, 8, and 18, respectively, but fails to expressly disclose if the server unit comprises a hypertext transfer protocol server configured to serve a hypertext markup language document to the remote client, with the hypertext markup language document including the fax document form.



Wolff discloses a network fax machine for faxing files received from a remote client (see Figs. 1 and 2), comprising a server unit (gateway 102) configured to send a fax document form to a remote client over a network (fax machine 101 via phone lines 104, see step 202 in Fig. 2, column 4, lines 18-42) and configured to receive fax information entered on the fax document form from the remote client (see Fig. 2), the fax information including an identifier corresponding to a destination fax machine (column 7, lines 29-62) and a file to be faxed to the destination fax machine (column 4, line 55-column 5, line 34), and a fax control unit configured to use the identifier to connect the network fax machine to the destination fax machine and configured to send the file to the destination fax machine by facsimile communication (column 5, lines 35-60, and column 6, line 38-column 8, line 8).

Further, Wolff teaches that the server unit comprises a hypertext transfer protocol server configured to serve a hypertext markup language document to the remote client, with the hypertext markup language document including the fax document form (column 8, line 32-column 9, line 27).

Geshwind & Wolff are combinable because they are from the same field of endeavor, being systems that transmit data via facsimile machines. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to the hypertext markup language teachings of Wolff within the system of Geshwind. The suggestion/motivation for doing so would have been that Geshwind's system would become updated with modern capabilities using the World Wide Web, as recognized by Wolff in column 1, lines 14-52. Therefore, it would have been obvious to combine the teachings of Wolff with the system of Geshwind to obtain the invention as specified in claims 2, 9, 14, and 19.

***Citation of Pertinent Prior Art***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

**Abe *et al.*** (U.S. Patent Number 6,057,938) discloses a system that forwards facsimile data using destinations entered on a fax cover sheet;

**Larson *et al.*** (U.S. Patent Number 5,943,137) discloses a system for creating and processing fax forms;

**Kurogane *et al.*** (U.S. Patent Number 5,126,858) discloses a picture image processing system that uses a job control sheet; and

**Baran** (U.S. Patent Number 4,893,333) discloses an interactive facsimile system for retrieving information stored on a database.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The examiner can normally be reached on Monday-Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa  
Primary Examiner  
Art Unit 2622



jrp